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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/743,671

12/24/2003

Kia Silverbrook

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24011 7590 12/19/2006  
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393 DARLING STREET  
BALMAIN, NSW 2041  
AUSTRALIA

EXAMINER

LE, KHANH H

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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30 DAYS

12/19/2006

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Notice of Non-Compliant  
Amendment (37 CFR 1.121)**

Application No.

10/743,671

Examiner

Khanh H. Le

Applicant(s)

SILVERBROOK ET AL.

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The amendment document filed on 09 October 2006 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
  - ☐ B. New paragraph(s) should not be underlined.
  - ☐ C. Other \_\_\_\_\_.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
  - ☐ B. Other \_\_\_\_\_.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
  - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
  - ☐ C. Other \_\_\_\_\_.
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
  - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
  - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
  - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
  - ☒ E. Other: See attached Office Action.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):  
\_\_\_\_\_

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

**TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:**

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment** must be resubmitted.
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a *Quayle* action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

**Extensions of time** are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action.

**Failure to timely respond** to this notice will result in:

**Abandonment** of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a *Quayle* action; or

**Non-entry** of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable

Telephone No.

### **DETAILED ACTION**

1. This Office Action is responsive to the Correspondence filed October 09, 2006 . Claims 1 and 8 are amended. Claims 5-7, and 12-14 are cancelled. Claims 1-4, 8-11 are now pending. Claims 1 and 8 are independent.

### **Restriction by Original Presentation**

2. Newly amended claims 1-4, 8-11 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

3. Inventions I and II are directed to related processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect;

(2) the inventions do not overlap in scope, i.e., are mutually exclusive; and

(3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j).

4. In the instant case, the inventions as claimed have a materially different design, mode of operation, function, or effect.

Invention I is the previous claims 1-14:

Previous independent claim 1 (*numerals 1) to 3) added for clarity*) read:

*A method of tracking user interaction with an input element of a printed publication using a sensing device and a computer system, the method comprising the steps of, in the computer system:*

*1) printing, using a printer operatively connected to the computer system, the publication, the printed publication having disposed therein or thereon human-readable information and machine-readable coded data, the human-readable information and machine-readable coded data having been printed by the said printer, the human-readable information being indicative, to a user, of the input element, portions of the machine-readable coded data being indicative of their own position relative to the printed publication,*

*the computer system storing an electronic description of the printed publication and an association between the input element and an associated entity,*

*2) receiving, from a sensing device, indicating data, wherein the sensing device comprises:*

*(a) an image sensor adapted to capture images of at least some of the coded data when the sensing device is placed in an operative position relative to the printed publication; and*

*(b) a processor adapted to:*

*(i) identify at least some of the coded data from one or more of the captured images;*

*(ii) determine an orientation, within the captured images, of at least some of the coded data;*

*(iii) decode at least some of the coded data, using the determined orientation; and,*

*(iv) generate the indicating data being indicative of at least one of a position and a movement of the sensing device relative to the printed publication using at least some of the decoded coded data; and,*

*3) identifying, from the indicating data and the electronic description, whether the user has selected the input element using the sensing device and, if so, notifying the associated entity of the selection.*

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Thus Invention I is directed mainly to a method of tracking user interaction with a printed interactive publication using a sensing device and a computer system, wherein the printing step is only one of the steps .

Invention II is instant claims 1-4, 8-11.

Instant claim 1 reads:

*A method of printing a publication having an input element readable by a sensing device, the method comprising the steps of*

*a) determining a unique page identity for said publication in a computer system;*

*(b) identifying human-readable information for said publication;*

*(c) determining a page description for said publication in said computer system, said page description comprising:*

*(i) a description of said human-readable information and*

*(ii) a description of said input element including a zone of said input element on said page and a description of an associated entity;*

*(d) associating said page identity with said description of said input element;*

*(e) generating, in a printer, first dot data for coded data using said page identity. said coded data identifying said page identity and a plurality of positions on said publication;*

*(f) generating, in the printer second dot data for said human-readable information using at least part of said page description;*

*(g) compositing the first and second dot data; and*

*(h) printing the publication wherein the coded data is printed at the same time as printing the human-readable information using the composited dot data.*

Thus Invention II consists mainly of a method for printing the interactive publication, wherein the coded data is printed at the same time using a composited dot data and wherein a first dot data for coded data, and second dot data for human-readable data are generated in a printer, and composited together into said composited dot data while all the other steps of Invention I previously presented are canceled.

**Thus first, inventions I and II as claimed can have a materially different design, mode of operation, function, or effect** because as stated above, Invention I concerns tracking user interaction with an interactive publication for the purpose or effect of notifying the associated parties while invention II is concerned with printing such interactive publication with further printing limitations that are not necessary for the operation of Invention I. At least their mode of operations and effects are completely different.

Second, claims to two processes are mutually exclusive, i.e., do not overlap in scope, if one claim recites limitations disclosed for a first process but not a second, while a second claim recites limitations disclosed for a second process but not the first.

In other words, claims to the two processes do not overlap in scope because the first process would not infringe a claim to the second process, and the second process would not infringe a claim to the first.

Here invention I recites limitations disclosed for a first process but not a second, e.g. steps of 1) tracking user interaction, 2) *receiving, from a sensing device, indicating data, wherein the sensing device comprises several other components*, 3) *identifying, from the indicating data and the electronic description, whether the user has selected the input element using the sensing device and*, 4) *if so, notifying the associated entity of the selection*.

While Invention II recites limitations disclosed for a second process but not the first, i.e. limitations such as the coded data is printed at the same time using a composited dot data and

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wherein a first dot data for coded data, and second dot data for human-readable data are generated in a printer, and composited together into said composited dot data.

Here, Invention I (method of tracking user interaction with interactive paper, using a whole system involving the interactive paper, stylus, and tracking computer systems) would not infringe a claim to Invention II (method of printing such paper using at least compositing dots for coded and human-readable data) and Invention II would not infringe a claim to Invention I.

**Thus Inventions I and II are mutually exclusive, i.e., do not overlap in scope.**

Furthermore, there is nothing of record to show them to be obvious variants.

5. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-4, 8-11 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Thus the amendment in effect cancels all claims drawn to the elected invention (Invention I) and presents only claims drawn to a non-elected invention (Invention II) and thus is non-responsive (MPEP § 821.03). The remaining claims are not readable on the elected invention as explained above.

### ***Conclusion***

6. Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

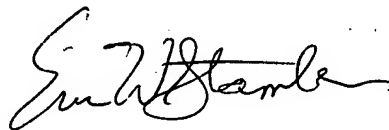
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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600.

December 11, 2006

KHL



ERIC W. STAMBER  
SUPERVISORY PATENT EXAMINER  
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